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OFFICE OF PETITIONS

In re Application of
McCloy, et al.
Application No. 09/495,105 : ON PETITION
Filed: 1 February, 2000 :
Attorney Docket No.: BRI.00026 :

This is a decision on the petition filed 13 January, 2003, in light of regulations at 37 C.F.R. §1.137(b)¹ to accept the delayed filing of a reply brief for consideration before the Board of Patent Appeals and Interferences.

The petition is **GRANTED**.

BACKGROUND

The record indicates that:

- in response to Appeal Brief filed on 7 March, 2002, the Examiner's Answer was mailed on 22 May, 2002;
- therefore, Petitioner's Reply Brief (should he elect to file one) or a request under ¶(b) of 37 C.F.R. §1.136 for an extension of time within which to file a Reply Brief was due on or before Monday, 22 July, 2002;
- instead, on Tuesday, 23 July, 2002, Petitioner filed the instant petition and proffered with it his Reply Brief;
- Because no extension of time was requested and obtained pursuant to 37 C.F.R. §1.136(b), the two month period for submission of a Reply Brief pursuant to 37 C.F.R.

¹ The regulations at 37 C.F.R. §1.183 sets forth that waiver of the rules is "subject to such other requirements as may be imposed."

§1.193(b) expired at midnight 22 July, 2002;

- on 23 July, 2002, the original petition was filed under 37 C.F.R. §1.183² requesting that the Office waive the timing requirements of 37 C.F.R. §1.193,³ which sets forth the period within which a reply brief must be filed;
- when the Reply Brief was filed on 23 July, 2002, in the absence of a previously submitted request for an extension of time under the provisions of 37 C.F.R. §1.136(b), the Reply Brief was untimely;
- the 23 July, 2002, Petition was dismissed on 9 December, 2002;
- the instant petition and fee was filed on 13 January, 2003..

The instant application is being forwarded to the Board of Patent Appeals and Interferences.

² The regulations at 37 C.F.R. §1.183 provide, in pertinent part:

§1.183 Suspension of the Rules.

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Commissioner or the Commissioner's designee, *sua sponte*, or on petition of the interested party, subject to such other requirements as may be imposed. * * *

³ The regulations at 37 C.F.R. §1.193 provide:

§1.193 Examiner 's answer and reply brief.

(a)(1) The primary examiner may, within such time as may be directed by the Commissioner, furnish a written statement in answer to appellant 's brief including such explanation of the invention claimed and of the references and grounds of rejection as may be necessary, supplying a copy to appellant. If the primary examiner finds that the appeal is not regular in form or does not relate to an appealable action, the primary examiner shall so state.

(2) An examiner's answer must not include a new ground of rejection, but if an amendment under §1.116 proposes to add or amend one or more claims and appellant was advised that the amendment under §1.116 would be entered for purposes of appeal and which individual rejection(s) set forth in the action from which the appeal was taken would be used to reject the added or amended claim(s), then the appeal brief must address the rejection(s) of the claim(s) added or amended by the amendment under § 1.116 as appellant was so advised and the examiner 's answer may include the rejection(s) of the claim(s) added or amended by the amendment under §1.116 as appellant was so advised. The filing of an amendment under §1.116 which is entered for purposes of appeal represents appellant 's consent that when so advised any appeal proceed on those claim(s) added or amended by the amendment under §1.116 subject to any rejection set forth in the action from which the appeal was taken.

(b)(1) Appellant may file a reply brief to an examiner's answer or a supplemental examiner's answer within two months from the date of such examiner's answer or supplemental examiner 's answer. See §1.136(b) for extensions of time for filing a reply brief in a patent application and §1.550(c) for extensions of time for filing a reply brief in a reexamination proceeding. The primary examiner must either acknowledge receipt and entry of the reply brief or withdraw the final rejection and reopen prosecution to respond to the reply brief. A supplemental examiner's answer is not permitted, unless the application has been remanded by the Board of Patent Appeals and Interferences for such purpose.

(2) Where prosecution is reopened by the primary examiner after an appeal or reply brief has been filed, appellant must exercise one of the following two options to avoid abandonment of the application:

(I) File a reply under § 1.111, if the Office action is not final, or a reply under §1.113, if the Office action is final; or

(ii) Request reinstatement of the appeal. If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (§§1.130,1.131 or 1.132) or other evidence are permitted.

[24 Fed. Reg. 10332, Dec. 22, 1959; 34 Fed. Reg. 18858, Nov. 26, 1969; para. (c), 47 Fed. Reg. 21752, May 19, 1982, added effective July 1, 1982; para. (b), 50 Fed. Reg. 9382, Mar. 7, 1985, effective May 8, 1985; 53 Fed. Reg. 23735, June 23, 1988, effective Sept.12, 1988; para. © deleted, 57 Fed. Reg. 2021, Jan. 17, 1992, effective Mar. 16, 1992; para. (b) revised, 58 Fed. Reg. 54504, Oct. 22, 1993, effective Jan.3, 1994; revised, 62 Fed. Reg. 53131, Oct. 10, 1997, effective Dec. 1, 1997; para. (b)(1) revised, 65 Fed. Reg. 54604, Sept. 8, 2000, effective Nov. 7, 2000]

Telephone inquiries concerning this decision may be directed to the undersigned at (703) 305-9199.



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